

### **REMARKS**

This Application has been carefully reviewed in light of the Final Office Action transmitted March 10, 2008 (the "Office Action"). The Office Action rejects Claims 1-5, 7-13, and 15-19. Applicant respectfully requests reconsideration and favorable action in this case.

#### **Section 103 Rejections**

The Examiner rejects Claims 1-5, 7, 9-13, 15, and 17-19 under 35 U.S.C. 103(a) as being unpatentable over European Patent Office Publication No. 1096713 to Yoshizawa et al. ("*Yoshizawa*") in view of U.S. Patent Publication No. 2002/0044315 to Sugawara et al. ("*Sugawara*") and further in view of U. S. Patent Publication No. 2006/0210274 to Lichtman ("*Lichtman*"). The Examiner rejects Claims 8 and 16 under 35 U.S.C. 103(a) as being unpatentable over *Yoshizawa* in view of *Sugawara*, as applied to Claims 1-5, 7, 9-13, 15 and 17-19 above, and further in view of U.S. Patent Publication No. 2002/0048066 to Antoniadis et al ("*Antoniades*"). Applicant respectfully traverses these rejections.

Claim 1 recites splitting at least one of the component signals into a drop signal and a continue signal at a drop card and selecting, at an add card separate from the drop card, between an add signal and the continue signal for communication on the network. Claims 9 and 17 recite similar elements. The Office Action admits that *Yoshizawa* does not disclose that the drop-splitting element and the add-splitting element of Figure 2A are realized as separate drop and add cards but states that:

Lichtman discloses an optical network with OADM where separate add and drop elements are implements as "modules" physically connected together (abstract) and Emery discloses an optical network with an OADM and defines a "module" as a card-pack equipped with optical modules to provide a specific functionality (fig. 1 and paragraphs 0047 and 0048). Since Yoshizawa discloses separate drop and add elements, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement the separate drop and add elements on separate card-pack 'modules', in light of Lichtman and Emery, to provide the benefits of being able to consolidate the functionalities of the different elements onto respectively removable and replaceable modularized cards.

Office Action, page 3. To establish a *prima facie* case of obviousness, the references must teach or suggest all elements of the rejected claims and it must have been obvious to one of ordinary skill in the art at the time of invention to combine or modify the references. *KSR Int'l Co. v.*

*Teleflex Inc.*, 127 S.Ct. 1727 (2007); *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In *KSR Int'l Co. v. Teleflex Inc.*, the Supreme Court clarified the appropriate standard to use when determining obviousness. Furthermore, the M.P.E.P. explicitly states, "[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. § 2143.03, citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984) (emphasis added); see also *KSR*, 127 S.Ct. at 1739 (when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious).

Applicant respectfully submits that *Yoshizawa* teaches away from the proposed modification of implementing its optical coupler 41 and 2 x 1 switch 42 on separate cards in order to support the Office Action's obviousness rejection. Making such a modification to the optical add/drop multiplexer of *Yoshizawa* would render *Yoshizawa* inoperable for its intended purpose. *Yoshizawa* is specifically directed on reducing complexity and cost and increasing reliability by modifying an optical add/drop multiplexer component by replacing its 2 x 2 switch with a 2 x 1 switch. See *Yoshizawa*, par. [0003] – [0004]. "[T]he configuration of such 2 x 2 SW is complex, compared with that of 2 x 1 SW, is inferior in reliability, and the cost is higher." *Id.* at par. [0003]. *Yoshizawa* also states that:

[T]he present invention provides OADM the reliability of which is high and the cost of which is low without use 2 x 2 SW. An optical add/drop multiplexer (OADM) according to the invention is provided with an optical demultiplexer (ODMX), a 2 x 1 optical switch and an optical multiplexer (OMUX), and is further provided with an optical coupler that branches a predetermined optical signal of optical signals which an optical demultiplexer demultiplexes from wavelength-multiplexed signal light into first and second branched optical signals.

*Id.* at par. [0004]. Thus, the purpose of the invention of *Yoshizawa* is to replace a 2 x 2 switch with a 2 x 1 switch on an optical add/drop multiplexer component. If the optical add/drop multiplexer were modified such that the switch (whether a 2 x 2 switch or a 2 x 1 switch) was merely on an independent separate card from other aspects of the multiplexer such as the optical coupler 41, then there would be no need for the invention of *Yoshizawa* since the switches would be replaceable without complexity and high cost. Instead, *Yoshizawa* teaches implementing the 2 x 1 switch on the optical add/drop multiplexer component to reduce complexity and cost of the multiplexer component. If the 2 x 1 switch were implemented on a separate card from the

coupler, *Yoshizawa* would be inoperable for its intended purpose. *Yoshizawa* therefore teaches away from the proposed modification.

Therefore, for at least these reasons, Applicant respectfully submits that Claims 1, 9, and 17 are patentable over the cited art used in the rejections and request that the rejections of these claims, and all claims depending therefrom, be withdrawn.

**CONCLUSION**

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad C. Walters, Attorney for Applicant, at the Examiner's convenience at (214) 953-6511.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,  
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